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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,025	07/09/2003	Sean O' Toole	7754.03	8771

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EXAMINER

FRANCIS, FAYE

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/615,025	O' TOOLE ET AL.	
	Examiner	Art Unit	
	Faye Francis	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-9, drawn to a collectable, classified in class 446, subclass 369.
- II. Claims 10-19, drawn to a method of making a collectable, classified in class 446, subclass 385.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process. For example the product recited in claims 1-9 can be made without the step of sizing as recited in the method claim 10 and without the step of rolling a towel as recited in the method claim 12. Additionally, the product recited in claims 1-9 can be made without the step of folding a towel.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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3. During a telephone conversation with Mr. Dolth Torrence on Friday June 18, 2004 a provisional election was made with traverse to prosecute the invention of I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 8-9: the claim language is confusing since it is not clear whether "a bean bag" in line 2 is the bean bag as in line 2 of claim 7 from which both claims 8 and 9 depend or is an additional one.

Furthermore, it is noted that claims 8 and 9 include the same limitations as in claim 7, i.e. the fabric surface layer and the fabric made from towels and

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beanbag. These limitations do not further structurally limit claim 7 and are redundant.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldfarb et al, hereinafter Goldfarb.

Goldfarb discloses in Figs 1 and 3, a collectible [doll] comprising: a core [upper compartment 21 containing foamed plastic beads], a filler material [lower compartment 3 containing dried beans], a fabric surface layer [casing 12], a fabric attachment [arm 24] wherein the core is situated inside the fabric surface layer and the fabric surface layer is stuffed with the filler material to form a body wherein the fabric attachment is attached to the body to form a body part shape. Additionally, Goldfarb discloses wherein the collectible has an overall, predetermined configuration which is substantially in the manner of an animal [examiner takes the position that a doll is an animal ["**doll**" A child's usually small toy representing a human being and **mam·mal** (màm¹el) *noun* Any of various warm-blooded vertebrate animals of the class Mammalia, including human beings, characterized by a covering of hair on the skin and, in the female, milk-producing mammary glands for nourishing the young according to Merrian-

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Webster's Collegiate Dictionary Tenth Edition] as recited in claims 1 and 7. Also, Goldfarb discloses the fabric surface layer and the fabric attachment are made from towels [cloth] as recited in claims 2 and 7, wherein the collectible further comprises one of an embroidered or sewn-in animal feature [facial features in Fig 1A] as recited in claims 4 and 8-9. Furthermore, Goldfarb discloses a plastic support piece [barrier means 22b] as recited in claim 5 and the collectible has an overall length which is less than 12% [col 3 lines 1-8] as recited in claim 6.

9. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Choi.

Choi discloses in Figs 1-3, a collectible [doll] comprising: a core [armatures 30, 40 and 50], a filler material [col 2 lines 65-66], a fabric surface layer [col 2 line 57], a fabric attachment [tail 12] wherein the core is situated inside the fabric surface layer and the fabric surface layer is stuffed with the filler material to form a body wherein the fabric attachment is attached to the body to form a body part shape and wherein the collectible further comprises one of an embroidered or sewn-in animal feature [facial features].

10. Claims 1 and 4 rejected under 35 U.S.C. 102(b) as being anticipate by Witkin.

Witkin discloses in Figs 1-3, a collectible [stuffed toy] comprising: a core [wire component 10], a filler material [wadding 32], a fabric surface layer [covering 16], a fabric attachment [arm 48] wherein the core is situated inside the fabric surface layer and the fabric surface layer is stuffed with the filler material to form a body wherein the fabric attachment is attached to the body to form a body

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part shape and wherein the collectible further comprises one of an embroidered or sewn-in animal feature [simulated eyes 58].

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfarb in view of VonPhilip, Sr, hereinafter VonPhilip.

Goldfarb discloses most of the elements of this claim but for wherein the fabric surface layer and the fabric attachment are made from 100% cotton terry cloth towels.

VonPhilip teaches that it is conventional to use a fabric made out of 100% cotton terry cloth to cover a stuffed toy [col 2 line 23]. It would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of VonPhilip to provide the device of Goldfarb with 100% cotton terry cloth covering to make the device more softer and more enjoyable for the children to play with.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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